

### **REMARKS**

This Application has been carefully reviewed in light of the Office Action dated April 1, 2008 ("Office Action"). Claims 1-8, 10, 11, 26 and 27 are pending in the application. The Examiner rejects Claims 1-8, 10, 11, 26 and 27. Applicant respectfully requests reconsideration and allowance of all pending claims.

### **Consideration of Information Disclosure Statements**

Applicant submitted Supplemental Information Disclosure Statements dated August 22, 2006; January 26, 2007; March 1, 2007; February 19, 2008; and April 30, 2008 which the Examiner has failed to consider. Each of these IDSs were timely filed. Pursuant to M.P.E.P. §609, Applicant respectfully requests the Examiner to consider all of the art cited in the Supplemental IDSs identified above, and in the event a patent issues on this Application, that this art be printed on the face of the issued patent. Furthermore, Applicant respectfully requests a copy of the PTO Form-1449 for the Supplemental IDSs identified above indicating the Examiner's consideration of the references.

### **Claim Rejections - 35 U.S.C. § 103**

The Examiner rejects Claims 1-8, 10, 11, 26 and 27 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,177,964 B1 issued to Birleson, et al. ("*Birleson*"), in view of U.S. Patent No. 7,196,737 B1 issued to Fulga, et al. ("*Fulga*"). Applicant respectfully requests reconsideration and allowance of all pending claims.

At the outset, Applicant respectfully requests the Examiner to withdraw the *Birleson-Fulga* combination as improper. Each of the cited references, *Birleson* and *Fulga*, specifically teach away from relevant aspects of Claim 1. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). (M.P.E.P. § 2141.02).

Applicant asserts that *Birleson* explicitly teaches away from "a filter operable to receive an input signal comprising a first number of television channels and further operable to communicate an intermediate output signal comprising a second number of television channels less than the first number of television channels," as recited, in part, in Claim 1. Indeed, *Birleson* states, "filter 101 passes all channels in the television band" (col. 7, ll. 61;

emphasis added); “amplifier 102 comprises a low noise amplifier (LNA) with a high linearity that is sufficient to pass the entire television band” (col. 7, l. 67 – col. 8, l.2; emphasis added); “[i]n operation, the front end of tuner 10 receives the entire television band through filter 101 and amplifier 102” (col. 8, ll. 40-41; emphasis added). Thus, *Birleson* explicitly teaches away from elements of Claim 1 no less than three times. Like *Birleson*, *Fulga* also teaches away from elements of Claim 1. In particular, *Fulga* actually cites to *Birleson* and states, “the input filter 101 is not tuned to select a few channels but instead passes all channels in the television band.” (Col. 2, ll. 66-67; emphasis added).

The Examiner’s continued reliance on the argument that, “by simply replacing the filter 101 of *Birleson* with the conventional filter, would render obvious the pending claims” (office Action, page 3), is impermissible where, as here, *Birleson* and *Fulga* both specifically teach away from the claimed invention. As both of the Examiner’s references teach away from the claimed invention, the *Birleson-Fulga* combination is improper and the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1.

With respect to Claim 2, the Examiner states that “the concept of filtering/tuning down the number of channels received has been evidenced above.” (Office Action, page 3). Applicant respectfully submits that this is incorrect. As described above, “filter 101” of *Birleson* (and *Fulga*) passes “**all channels** in the television band” and, therefore, the concept of “filtering/tuning down the number of channels” is expressly taught away by *Birleson* (and *Fulga*) with respect to “filter 101.” For at least this reason, and because Claim 2 depends from Claim 1 shown above to be allowable, Applicant respectfully requests reconsideration and allowance of Claim 2.

The Examiner makes similar improper rejections of the remaining dependent and independent claims. Applicant respectfully traverses all the rejections made in this Office Action. For at least the reasons set forth above with respect to Claims 1 and 2, Applicant respectfully requests reconsideration and allowance of Claims 3-8, 10-11, and 26-27.

**CONCLUSION**

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of all pending claims.

If there are matters that can be discussed by telephone to further the prosecution of this Application, Applicant invites the Examiner to call the undersigned attorney at (214) 953-6581 at the Examiner's convenience.

Applicant believes that no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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